

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/743,321
Applicant(s) : Peter ELMS
Filed : December 23, 2003
TC/A.U. : 3623
Examiner : Not Yet Assigned

Confirmation No.: 5565

Docket No. : 86769-0026
Customer No. : 30398

DECLARATION IN SUPPORT OF PETITION UNDER 37 C.F.R. §1.47(a)

Commissioner for Patents
Box: Missing Parts
Washington, D.C. 20231

Sir:

In support of a Petition Under 37 C.F.R. 1.47(a) for the above-referenced patent application, I, David D. Nelson, declare that I am a registered Patent Attorney, Registration No. 47,818, that I represent Accenture Global Services GmbH in connection with the preparation and prosecution of the present patent application, and that I am authorized to make the following statements:

(1) Accenture Inc. is a wholly owned subsidiary of Accenture Global Services GmbH. Accenture Global Services GmbH is a corporation of Switzerland and principally located at Geschäftshaus Herrenacker 15, 8200 Schaffhausen, Switzerland.

(2) Mr. Peter Elms was an employee of Accenture Inc. During his employment period, Mr. Elms, as part of his employment duties, participated in the development of the subject matter of the above-referenced patent application.

(3) After Mr. Elms left Accenture Inc, he retained separate patent counsel, as evidenced by letter of December 12, 2003 from James G. Gatto Esq., attached hereto as Appendix 1.

(4) According to Accenture, Inc.'s personnel records and as confirmed in a telephone conversation with Mr. Gatto, Mr. Elms' current correspondence address is 4215 Oakridge Lane, Chevy Chase, Maryland 20815.

(5) I forwarded to Mr. Elms, through his attorney Mr. Gatto, a letter forwarding a Declaration document and a copy of the complete application as filed. A copy of this letter is attached hereto as Appendix 2.

(6) On June 10, 2004, I received a letter from Mr. Gatto confirming that Mr. Elms had received the letter of May 18, 2004 containing the attached Declaration document and the copy of the complete application as filed. Mr. Gatto further indicated that Mr. Elms was refusing to sign the application without further compensation. A copy of this letter is attached hereto as Appendix 2.

(7) On or approximately October 25 2004, I spoke with an associate of Mr. Gatto, who indicated that Mr. Elms would not execute the Declaration document unless Accenture Inc. paid an exorbitant fee of \$15,000.

(9) I have received no other response or correspondence from Mr. Elms or his counsel. I make this declaration to prevent abandonment of the subject patent application as Mr. Elms is required to execute the Declaration and Power of Attorney but has not yet done so.

Application No. 10/743,321

Declaration in Support of Petition under 37 C.F.R. 1.47(a) dated November 4, 2004

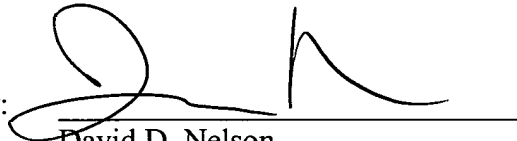
Notice to File Missing Parts dated April 5, 2004

I further declare that all statements made herein of my own knowledge are true; that all statements made on information and belief are believed to be true; that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001; and that such willful false statements may jeopardize the validity of the application or document or any resulting registration resulting therefrom.

Respectfully submitted,

Dated: November 4, 2004

By:

A handwritten signature in black ink, appearing to read 'D. Nelson', is written over a horizontal line.

David D. Nelson

Registration No. 47,818

Hogan & Hartson, L.L.P.

555 13th St., N.W.

Washington, DC 20004

Telephone: (202) 637-5497

Facsimile: (202) 202-637-5910

Customer No. 30398

MINTZ LEVIN
COHN FERRIS
GLOVSKY AND
POPEO PC

Reston
Boston
New York
Washington
New Haven

12010 Sunset Hills Road
Suite 900
Reston, Virginia 20190-5839
703 464 4800
703 464 4895 fax
www.mintz.com

James G. Gatto
Member

Direct dial 703 464 8182
jggatto@mintz.com

June 9, 2004

BY FEDERAL EXPRESS

Celine J. Crowson, Esquire
Hogan & Hartson, L.L.P.
Columbia Square
555 Thirteenth Street, NW
Washington, DC 20004-1109

HOGAN & HARTSON L.L.P.

JUN 10 2004

IP DOCKETING DEPT.

Re: U.S. Patent Application Serial No. 10/743,321
Filed: December 23, 2003
For: "SECURE ELECTRONIC REGISTRATION AND VOTING SOLUTION"
Your Reference: 86769-0026US
Our Reference: 23906-002

Dear Ms. Crowson:

Further to your letter of May 18, 2004, Mr. Elms is willing to sign the Declaration, subject to resolution of various issues, some of which are addressed below. I suggest that we arrange for a telephone conversation to discuss the issues further.

Regarding the Declaration, Mr. Elms notes that the information listed for him is not correct. He is in fact a citizen of Canada. Furthermore, Mr. Elms is not able to sign the Declaration at this point because he believes he is the sole inventor of the subject matter claimed therein. As you recall, Mr. Elms is the sole inventor listed in the provisional application from which this utility application claims priority. The claims of the utility application appear to be supported by the contributions made by Mr. Elms alone. Please provide an explanation of why David K. Black, Emmett H. Fremaux, Niten Malik and Carl Almond are added to the utility application.

Furthermore, regarding a review of the content of the patent application for accuracy, completeness and compliance with 35 U.S.C. Section 112 (including satisfaction of the best mode requirement), Mr. Elms is willing to undertake the necessary review provided he is given reasonable compensation for his time. Please let us know if your client is willing to agree to reasonable compensation, and if so, please provide us a proposal that we may present to Mr. Elms.

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.

Celine Crowson, Esquire

June 9, 2004

Page 2

Mr. Elms also wants to make sure that when he signs, he will be ensured that all prior art and other information of which he is aware will be submitted to the United States Patent and Trademark Office to comply with the duty of disclosure. Please confirm that, subject to the foregoing, if Mr. Elms signs, you will submit all of the information he provides to the USPTO.

I look forward to your response, and to discussing this matter further.

Sincerely,

James G. Gatto / bcb
James G. Gatto

JGG

HOGAN & HARTSON

L.L.P.

CELINE JIMENEZ CROWSON

PARTNER

(202) 637-5703

CJCROWSON@HHLAW.COM

May 18, 2004

COLUMBIA SQUARE

555 THIRTEENTH STREET, NW

WASHINGTON, DC 20004-1109

TEL (202) 637-5600

FAX (202) 637-5910

WWW.HHLAW.COM

BY FEDERAL EXPRESS

James G. Gatto, Esquire
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, PC
12010 Sunset Hills Road
Suite 900
Reston, Virginia 20190-5839


Re: U.S. Patent Application No. 10/743,321
Entitled: SECURE ELECTRONIC REGISTRATION AND
VOTING SOLUTION
Inventors: ELMS, Peter et al.
Your Ref.: 23906-002
Our Ref.: 86769-0026US

Dear Mr. Gatto:

Further to your letter of December 12, 2003, enclosed for Mr. Elm's records is a copy of the specification and figures for the above referenced patent application, which was filed in the U.S. Patent and Trademark Office (USPTO) on December 23, 2003. After reviewing the application, Mr. Elms should execute and return the enclosed Declaration form so that we may file this document with the USPTO to avoid abandonment of the patent application.

Please note that if we do not receive the executed Declaration Form within three weeks (June 8, 2004), we take steps as necessary to preserve the patent application.

Your truly,



Celine Jimenez Crowson

CJC/DDN:dm

Enclosures:

Application

Figures

Declaration

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837J 7839 2190

1 From Please print and press hard.
Date 5-18-04 Sender's FedEx Account Number 0200-0273-5

Sender's Name **CARLINE JIMENEZ CROWSON** Phone (202) 637-5826

Company **HOGAN & HARTSON LLP**

Address **555 13TH ST NW STE 800E**

City **WASHINGTON** State **DC** ZIP **20004**

2 Your Internal Billing Reference **86769-00260US**

3 To Recipient's Name **James G. Gatto, Esq** Phone ()

Company **MINTZ, LEVIN, COHN, FERRIS, GLOVSKY + POPEO, PC**

Address **12010 SUNSET HILLS ROAD**
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FedEx Envelope rate not available. Minimum charge: One-pound rate

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☐ FedEx 2Day Freight Second business day
☐ FedEx 3Day Freight Third business day

* Call for Confirmation.

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☐ HOLD Weekday at FedEx Location NOT Available for FedEx First Overnight
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7 Payment Bill to:

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☐ Third Party
Enter FedEx Acct. No. or Credit Card No. below.

FedEx Acct. No. Credit Card No.

Total Packages Total Weight Total Declared Value

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By signing this Airbill you authorize us to deliver this shipment without obtaining a signature and agree to indemnify and hold us harmless from any resulting claims.

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447

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**MINTZ LEVIN
COHN FERRIS
GLOVSKY AND
POPEO PC**

*Boston
Washington
Reston
New York
New Haven
Los Angeles
London*

HOGAN & HARTSON L.L.P.

DEC 15 2003

IP DOCKETING DEPT.

*12010 Sunset Hills Road
Suite 900
Reston, Virginia 20190-5839
703 464 4800
703 464 4895 fax
www.mintz.com*

**James G. Gatto
Member**

*Direct dial 703 464 8182
jggatto@mintz.com*

December 12, 2003

Reynold Aust, Esquire
Hogan & Hartson L.L.P.
555 Thirteenth Street, N.W.
Washington, D.C. 20004

Re: U.S. Patent Application
Serial No.: 60/444,885
Filed: February 5, 2003
Title: "Secure Electronic Registration and Voting Solution"
Our Reference: 23906-002

Dear Mr. Aust:

I represent Peter Elms in connection with patent matters. I understand that you have prepared and filed a provisional patent application naming him as an inventor. I also understand that you have requested that Mr. Elms sign certain documents associated with the application. I understand that there may be some additional issues that need to be addressed. Since Mr. Elms is no longer an employee, I am sure you can appreciate that he does not want to spend a significant amount of time on these issues.

I also understand that Mr. Elms may be aware of some prior art that may be relevant to the patentability of the application. Pursuant to the duty of disclosure, Mr. Elms will identify this information (as discussed below) and I am sure you will disclose this information to the United States Patent and Trademark Office to comply with the duty.

To expedite resolution of any issues that remain, we request that all issues be identified and addressed at one time. To this end, I request that you provide me with the following:

1. A copy of all documents for which you request Mr. Elm's signature
2. A copy of the provisional application(s) as filed and any utility application(s) filed or to be filed; and

3. All agreements that exist between your client and Mr. Elms that relate to any rights or obligations concerning the patent application.

Once we have all of the requested information we will discuss resolution of all remaining issues and Mr. Elm will provide disclosure of the prior art of which he is aware.

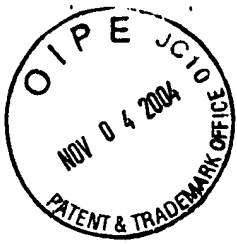
Please direct all future correspondence regarding these patent matters to me.

Very truly yours,


James G. Gatto

JGG/mrs

cc: Michael B. Chernoff
Peter Elms



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant(s) : Peter ELMS
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Docket No. : 86769-0026
Customer No. : 30398

PETITION UNDER 37 C.F.R. §1.47(a)

Commissioner for Patents
Attn: Box: Missing Parts
Washington, D.C. 20231

Dear Sir:

Applicants hereby petition under 37 C.F.R. §1.47(a) to file the present application without the signature of one (1) of the inventors on an Oath or Declaration. Submitted herewith is a Declaration for Patent Application identifying the present application by Application number and by filing date. The Joint Declaration and Power of Attorney is signed by all except one of the inventors (David K. Black, Emmett H. Fremaux, Niten Malik and Carl Almond) and has a blank signature block for the non-signing inventor (Peter Elms). In accordance with MPEP §409.03(a)(A), this Declaration for Patent Application may be treated as having been signed by all the available inventors on behalf of the nonsigning inventors.

Further attached herewith is a Declaration in Support of the Petition under 37 C.F.R. §1.47(a) [hereafter the "Declaration"] describing the diligent efforts made to contact the non-signing inventor, Mr. Elms, who refuses to sign the Joint Declaration and Power of Attorney. As further described in the Declaration, Mr. Elms was an employee of the assignee of the present application during the time of invention and is under a legal obligation to sign an Oath or Declaration.

11/05/2004 GWORDDOF1 00000104 501349 10743321

01 FC:1460 130.00 DA

Petition Under 37 C.F.R. 1.47(a) dated November 4, 2004
Notice to File Missing Parts dated April 5, 2004

The last known address for the non-signing inventor, Mr. Elms, is:


4215 Oakridge Lane
Chevy Chase, Maryland 20815

Also submitted herewith is a check for the Petition fee of \$130 as specified in 37 CFR §1.17(h). Please charge any deficiencies and credit any overpayment to the Deposit Account No. 50-1359 of the undersigned.

Respectfully submitted,

Dated: November 4, 2004

By:


Celine Jimenez Crowson
Registration No. 40,357

David D. Nelson
Registration No. 47,818

Hogan & Hartson, L.L.P.
555 13th St., N.W.
Washington, DC 20004
Telephone: (202) 637-5497
Facsimile: (202) 637-5910
Customer No. 30398